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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Application of: Joseph Tesler

Patent Application

Serial No.: 09/829,619

Art Unit: 2854

Examiner: Daniel James Colilla

Filing Date: April 10, 2001

For: Jewish Religious Scrolls

Attorney Docket No.: 1481.007


Board of Patent Appeals and Interferences
Commissioner for Patents
P.O. Box 1450
Arlington, Virginia 22313-1450

Transmittal Letter (28 pages total)


Further to the Notice of Appeal filed August 22, 2005, enclosed please find Applicant's Appeal Brief. A three month extension is requested of the time provided for response. Authorization is hereby provided to debit the amounts due for the Appeal Brief, the extension fee, and any further amounts deemed required, from Deposit Account No. 50-1604.

Dated: January 23, 2006

Respectfully submitted,


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Morris E. Cohen
Transmission Date: January 23, 2006

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APPEAL BRIEF

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I. Real Party in Interest

The real party in interest in the present application is the inventor, Rabbi Joseph Tesler.

II. Related Appeals and Interferences

There are no appeals or interferences currently known to appellant or appellant's legal representative which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status of Claims

Claims 1-12 and 21-33 are pending in this application and are the subject of the present appeal.

Claims 13-20 were withdrawn pursuant to the Examiner's election requirement.

A copy of the claims on appeal are presented in the attached Appendix.

IV. Status of Amendments

No amendments have been filed subsequent to final rejection.

V. Summary of Invention

The present invention is directed to new methods for preparing Jewish religious scrolls, articles that are meant for religious use and are subject to the detailed requirements of Jewish law. In one embodiment, such religious scrolls are created on animal parchment using a method that is intended to be simultaneously both automated and by hand. Further claims reciting methods using

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silk screening, ultraviolet or heat sensitive inks, and so forth, are provided as well, as explained in further detail below.

VI. Issues

Whether Claims 1-6, 27 and 31 are patentable, or whether they are obvious under 35 U.S.C. §103(a) over "applicant's disclosure of the prior art in view of Erickson".

Whether Claims 7-8 are patentable, or whether they are obvious under 35 U.S.C. §103(a) over "applicant's admission of prior art in view of Erickson, as applied to claims 1-6, and further in view of Churchwell".

Whether Claims 1-6, 27 and 31 are patentable, or whether they are obvious under 35 U.S.C. §103(a) over "applicant's disclosure of the prior art in view of Erickson".

Whether Claims 8-10 are patentable, or whether they are obvious under 35 U.S.C. §103(a) over "applicant's admission of prior art in view of Erickson, as applied to claims 1-6, 27 and 31, and further in view of Dunson".

Whether Claim 11 is patentable, or whether it obvious under 35 U.S.C. §103(a) over "applicant's admission of prior art in view of Erickson, as applied to claims 1-6, 27 and 31 above, and further in view of Hackett".

Whether Claims 12, 29 and 32 are patentable, or whether they are obvious under 35 U.S.C. §103 over "applicant's admission of prior art in view of Erickson, as applied to claims 1-6, 27 and 31 above, and further in view of Libby".

Whether Claims 21-22, 26, 28, 30 and 33 are patentable, or whether they are obvious under 35 U.S.C. §103(a) over "applicant's disclosure of the prior art in view of Erickson".

Whether Claims 23-25 are patentable, or whether they are obvious under 35 U.S.C. §103(a) over "applicant's admission of prior art in view of Erickson, as applied to claims 1-6, 27 and 31 above, and further in view of Churchwell."

VII. Grouping of Claims

Pursuant to 37 C.F.R. §1.192(c)(5), Applicant submits that the claims fall into the following groupings:

- | | |
|----------|--|
| Group 1 | New Method for Creating a Jewish Religious Scroll That Is Simultaneously Automated and by Hand: Claims 1-5 |
| Group 2 | New Method for Creating a Jewish Religious Scroll Using a Silk Screening Process Applied to Kosher Parchment: Claims 6, 11, 21 |
| Group 3 | New Method for Creating a Jewish Religious Scroll Using Ultraviolet or Heat Sensitive Inks: Claims 7-10, 23-25 |
| Group 4 | New Method for Creating a Jewish Religious Scroll on Kosher Parchment with Attached Crowns: Claims 22, 27, 28, 33 |
| Group 5: | New Method for Creating a Jewish Religious Scroll Using Sirtut: Claims 12, 29, 30, 33 |
| Group 6: | New Method for Creating a Jewish Religious Scroll in Ritual Manner: Claims 26, 31, 32, 33 |

Each of these groups are separately patentable from the others. Within each group, the claims stand or fall together with respect to the patentability of the subject matter claimed therein, due to the particular limitations recited as summarized above, and further discussed below.

VIII. Argument

A. *Various References of Record Have Not Been Shown to Qualify As Prior Art*

Previously, the claims were all rejected based upon an article dated March 8, 2000 in Dei'ah ve Dibur ("the Dei'ah ve Dibur article"). In his responses thereto, Applicant objected to the use of the Dei'ah ve Dibur article as not being prior art. The Examiner subsequently so acknowledged, and does not further rely upon it. As a result, other than using "applicant's own disclosure", the claims stand rejected based upon the following remaining references:

- (1) Erickson (U.S. Patent No. 3,532,052);
- (2) Churchwell (U.S. Application No. 2002/0100387);
- (3) Dunson (U.S. Patent No. 6,470,800);
- (4) Hackett (U.S. Pat. App. No. US 2001/0031335 A1 filed Dec. 18, 2000); and,
- (5) Libby (U.S. Patent No. 5,045,378).

Of these references, Churchwell is also not prior art. Likewise, an adequate showing has not been made that Dunson or Hackett qualifies as prior art.

1. *Churchwell is Not Prior Art*

Applicant has a priority date of February 23, 2000 based upon his U.S. Provisional Application Serial No. 60/184,258 filed February 23, 2000. Churchwell has a nonprovisional filing date in January 2002 and a provisional filing date in January 2001.

This demonstrates that Churchwell is not prior art to Applicant. Applicant filed in February 2000—i.e. almost a year before Churchwell. Applicant is prior to Churchwell, and not the other way around. Accordingly, it is respectfully submitted that the Churchwell reference should be withdrawn from consideration and that the rejections of claims 7-8 and 23-25 based on Churchwell in combination with Erickson should be reversed.

2. *Dunson and Hackett Have Not Been Shown to Be Prior Art*

The disclosure of the Dunson reference being relied upon (U.S. Patent No. 6,470,800) has a nonprovisional filing date of June 2000. The disclosure of the Hackett reference (U.S. Application No. US 2001/0031335 A1), has a nonprovisional filing date of December 18, 2000. Both the Dunson and Hackett nonprovisional applications were filed after Applicant's priority date of February 2000.

It should be noted that Dunson and Hackett (unlike Churchwell) each claim priority to provisional applications in 1999. However, the rejections were based upon the disclosures of the Dunson and Hackett patents, whose disclosures reproduce the nonprovisional applications filed after Applicant. For rejections to be issued based on the provisional applications, it is submitted that any relevant disclosure being relied upon needs to be shown in the provisional application. No such showing has been made. It is very common for nonprovisional applications to have new disclosure that was not in the provisional. It cannot be simply assumed that the information relied upon was also in an earlier document, particularly since that is often not the case.

As a result, it is submitted that it is improper to rely upon Dunson or Hackett, unless the text of the provisionals is provided and relevant pages (if any) are referenced so that Applicant has the ability to respond thereto. Applicant reserves the right to comment on any such contents and/or to antedate those references if it turns out that there is any relevant subject matter therein, but would need for them to be produced and particular disclosure cited to do so. Otherwise, Applicant is improperly being forced to treat provisional documents as prior art without any evidence that they so qualify, and is forced to comment on the contents of documents not in the record.

Thus, absent such a showing that Dunson and Hackett's provisionals qualify as prior art, the rejection of claims 8-11 based on those references in combination with Erickson should be reversed.

B. Claims 1-12 are Not Obvious Under the Accepted Legal Standards Pertaining to §103

With respect to obviousness, the Supreme Court has stated in its well-known and landmark *Graham* decision as follows:

Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy. . .

See, Graham v. John Deere, 383 U.S. 1, 148 USPQ 459 (1966) (emphasis added). Here, with respect to the scope and content of the prior art, the relevant field is the art of preparing a Jewish religious scroll, the only field to which these claims pertain. It is against this background that the claims must be analyzed and evaluated.

The field of preparation of Jewish religious scrolls¹ involves extremely detailed laws and traditions set forth in many volumes of legal texts codifying and analyzing the many nuances of Jewish law.² In determining whether the claims are obvious, it is critical that the background of this

¹ A Jewish religious scroll is defined as a Torah, Tefillin, or Megillah, three different ancient types of scrolls used in Jewish religious observance.

² In fact, it is beyond the ability of the Patent Office to determine whether the scrolls fully comport with these laws, i.e. whether they are to be deemed kosher under the applicable

art be given its due weight, to determine whether the invention would be obvious to one of ordinary skill in that art. "The perspective from which these [Graham] findings are made, as well as the ultimate question of obviousness, *is that of a person of ordinary skill in the field of invention*" (emphasis added herein). See, *Glaverbel Societe Anonyme et al. v. Northlake Marketing & Supply, Inc.*, 45 F.3d 1550, 1555 (Fed. Cir. 1995).

There is no evidence in the record that one of ordinary skill in that art has ever taught or suggested a method for preparation of a Jewish religious scroll on animal parchment, which is simultaneously both automated and by hand. Nor would it be obvious to do so.

There are various reasons for this. For example, under Jewish law the scroll must be handwritten. Machine printing of a scroll is entirely unacceptable. In fact, any scroll produced by machine is deemed completely invalid for ritual use under Jewish law.

In view of this very strict religious consequence, it appears that those of ordinary skill in this art have not given serious consideration to the possibility of automation, or have dismissed it out of hand. This is likely because automated scroll production is normally associated with production by machine. Applicant, an ordained Orthodox rabbi, is apparently the first to conceive that a method might be developed in this art which constitutes production by hand, but is nonetheless somehow automated. This would allow one to more rapidly fulfill the stringent and unalterable Jewish legal requirements for handwriting, while still somehow increasing the speed of scroll production.

Yet, even after conceiving that such a method might potentially be possible, Applicant still had to engage in research and development to achieve the scrolls of the invention. This was due to

regulations set forth for scores of generations. Rather, that is a matter for rabbinical and scholarly debate.

the numerous Jewish laws that had to be addressed, as well as the fact that any method which increases the speed of hand writing of the scroll is itself potentially problematic by its very nature. For example, one of the many laws applicable to these scrolls provides that no two letters may come into contact on the scroll, even by accident. If even a single slight smear of ink or error does this – anywhere among the many thousands of letters on the scroll – the full scroll is totally invalidated. It would be expected that a method which uses handwriting but automates or speeds it up would increase the risk of such accidents. Such a method would therefore tend to be avoided, as such an occurrence would invalidate the entire scroll, which traditionally has been associated with long work over weeks, months or years. Thus, within this field, where the inquiry must be directed, this is all evidence that an invention such as Applicant's would be avoided.

C. The Long Felt Need for this Invention is Further Evidence of Non-Obviousness

It is further notable that the laws and traditions governing the preparation of these scrolls are very rigorous and go back for literally thousands of years. The traditional processes are very time consuming, and result in scrolls which are extremely expensive. A Torah scroll, the most lengthy of the three scrolls, usually costs tens of thousands of dollars, and is usually more expensive than many automobiles.

However, at the same time, Jewish law provides a requirement for those bound by it to write their own scroll – something that few subject to it ever fully achieve in view of the difficulty of doing so. Previously, no one appears to have adequately met this need or conceived of a means to do so in the several millenia that these scrolls have been produced. Applicant is believed to be the first to have met this long felt need.

Objective evidence of this nature must be considered and given its proper due toward the consideration of non-obviousness. *Glaverhel*, 45 F.3d at 1555; *Stratoflex, Inc. v. Aeroquip Corp.* 713 F.2d 1530, 1538-39 (Fed. Cir. 1983) (evidence of secondary considerations must be considered and may be the most probative evidence in the record). That this long felt need has only now been met for the first time in such an extensively long period is extremely significant evidence of the non-obviousness of the present invention.

D. The References of Record Do Not Even Relate to the Subject Matter of Claims 1-5

Claims 1-5 are directed to a method for preparing a Jewish religious scroll on kosher parchment with a human hand, wherein the placement of text is automated such that multiple letters are placed onto the parchment with a single movement of the human hand. Under the applicable legal standards, it is submitted that all of the inventions of claims 1-5 are patentable.

These claims were rejected under §103(a) based on "applicant's disclosure of the prior art in view of Erickson". However, in so doing, applicant's disclosure is being used improperly. Outside of Applicant's disclosure of his invention, there is absolutely no evidence of record that Erickson pertains in any way to the centuries of prior art regarding preparation of Jewish religious scrolls.³ Plainly, the methods and practices in Erickson have nothing to do with preparation of these scrolls, and conversely, the methods and practices in the prior art of this field for thousands of years

³ Erickson pertains to silk screening, but as the language of the claim demonstrates, the claim does not relate to the field of silk screening. Experimentation with, and modification of, silk screening technology was ultimately part of Applicant's solution, but there has been no showing that it had bearing on the field of these scrolls before Applicant's inventive efforts. It was part of Applicant's invention that he thought to do so, departing from the accepted teachings and expectations of his field.

have nothing whatsoever to do with Erickson. There is simply no teaching or suggestion which would lead one to combine the two. The only basis for this is Applicant's disclosure, but reliance upon it is impermissible by law. *See, In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) ("The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure") (emphasis added).

In fact, while Erickson was cited on the grounds of obviousness, it (like the other references being relied upon), is not even analogous art. To be analogous, the art must either be in the field of applicant's endeavor or, if not, must be reasonably pertinent to the particular problem with which the inventor was concerned. *See e.g.*, MPEP 2141.01(a) (8th Ed., Rev. 2 May 2004), *citing, In re Oetiker*, 977 F.2d 1443, 1446 (Fed. Cir. 1992). Erickson is not in Applicant's field of endeavor – the preparation of Jewish religious scrolls. Nor did it have any reasonable pertinence to the issues involved with the preparation of such scrolls before Applicant developed his invention. Only after Applicant's research and development to develop his method would one look back and allege Erickson's relevance. There is no evidence that prior to Applicant's disclosure, one of ordinary skill in the art would have considered Erickson to have any pertinence to this field.

Likewise, it must be emphasized that it is the subject matter of the claims which must be shown to be obvious, and not the generalized discussion in the disclosure. Erickson does not appear to have any suggestion pertaining to the actual elements recited in the claims. Erickson has nothing to do with a method for preparing a Jewish religious scroll. It also has nothing to do with the problems associated with printing on kosher animal parchment, an unusual substrate material.

Likewise, while Erickson was cited because it teaches silk screening, claims 1-5 do not claim silk screening. They claim a method which is simultaneously intended to be by hand and automated

onto this unique substrate. Claim 1, for example, is directed to a method which is specifically automated such that 1) multiple letters are 2) placed on said kosher parchment 3) with a single movement of the human hand; and 4) without any two letters coming into contact. Erickson does not appear to have any discussion or suggestion regarding combining or attempting to achieve these four objectives.⁴

In fact, even the Examiner himself initially recognized that such claims must be read in view of their field, and based thereon originally held such type claims to be patentable. In the Office Action of May 14, 2002 in the parent application (Serial No. 09/792,474), the Examiner found that claims of this nature presented allowable subject matter. As the Examiner ruled:

"Claims 1-12 have been indicated as containing allowable subject matter because the prior art of record does not disclose or teach the method of preparing a Jewish religious scroll including the steps of placing text on the parchment with a human hand such that the placement of the text is automated in order to produce a kosher religious scroll."

See, U.S. Patent Application Serial No. 09/792,474, Office Action of May 14, 2002 at page 4. No evidence in the field of Jewish religious scrolls anticipating or making the claims obvious was found by the Examiner, and thus, the initial claims were found to be allowable. (The only objections to the claims were minor informalities, in which minor revision was required to provide proper antecedent basis).

⁴ Moreover, even if these claims had recited silk screening (which they do not), the problems and issues associated with preparation of a religious scroll would lead one away from the use of silk screening, as discussed in Section VIII.E below.

This holding of allowability was withdrawn, however, in the present continuation. It is believed that the Examiner's supervisor believed the claims to be too broad or to have some similar perspective, and therefore, rejections were subsequently issued based on references such as Erickson and the remainder listed above. But it is respectfully submitted that such a generalized belief does not replace the need to evaluate the invention with due reference to the perspective of one of ordinary skill in the particular art to which the invention pertains.

Nor should such an about-face have been lightly undertaken. *See*, MPEP §706.04 (8th Ed., Rev. 2 May 2004) (Great care should be exercised in authorizing rejection of a claim previously noted as allowable). In fact, the Examiner's initial instinct was correct: the field of claims 1-5 is the ancient art of preparation of Jewish religious scrolls, and within that field, the claim is entirely novel and nonobvious.

E. Erickson Also Does Not Teach or Suggest the Subject Matter of Claims 21-33

Claims 21-33 were rejected under §103 using Erickson as the primary reference in combination with "applicant's disclosure of prior art" (and using various other references for certain dependent claims). It is respectfully submitted that Erickson does not teach or suggest the subject matter of these claims; on the contrary, the evidence of record fully indicates that the invention is non-obvious.

To establish a *prima facie* case of obviousness, three basic criteria must be met. *See*, MPEP §2143 (8th Ed., Rev. 2 May 2004). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable

expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The Examiner has failed, however, to meet these requirements.

For the first requirement, the suggestion or motivation must be in the references themselves or in the knowledge generally available to one of ordinary skill in the art. No such suggestion or motivation has been shown in any art of record to modify the references to achieve the requirements of the claims, or to combine the references. The only suggestion is based in Applicant's disclosure which is not relevant. *See, In re Vaeck*, 947 F.2d 488 (the teaching or suggestion must be found in the prior art not applicant's disclosure).

Essentially, the Examiner is treating the claims as if they were merely reciting the silk screening of a document, and then rejecting the claims on the ground that the silk screening of any document is obvious. But that treatment is improper, for the claims are not directed to just any document, they are directed to the very specialized article recited in the claim. Jewish religious scrolls are not just "any" document. They have unique and very stringent specifications with respect to their composition, their structure, and their preparation. The words of the claims have meaning, and their express requirements should not be ignored. It was not at all obvious that the requirements for such articles could be compatible with a silk screening method, and it was Applicant's development of a means to reconcile the two which constitutes invention.

Nor has any such suggestion or motivation to do so been shown in the knowledge of those ordinary skill in this art. In this art, and from the perspective of one of ordinary skill, no one has previously recognized in centuries of work that one could potentially comport with the religious laws

while still producing the scroll in the claimed manner.⁵ This is highly probative evidence of non-obviousness.

Silk screening is a very old process, which has been around for hundreds or possibly over a thousand years. Some have traced this process back to China and Japan as far back as 960 - 1280 C.E. Likewise, the preparation of Jewish religious scrolls is an ancient process, dating back several thousand years.

There has been an extensive period of co-existence between the two processes. Yet, no prior art has been found at all referring to any suggestion in that entire period to prepare these religious scrolls using silk screening, or even attempt to do so. Not even one prior art reference has been found so teaching or suggesting. *If the subject of these claims was so obvious, it would not have taken centuries before someone provided the method being claimed.* This is compelling evidence of non-obviousness.

The Examiner has also not shown any evidence of a reasonable expectation of success. Rather, the evidence of record shows the very opposite.

As discussed, a Jewish religious scroll must be prepared pursuant to the very stringent and meticulous requirements of Jewish law (the *Halakha*). Pursuant to these laws, the creation of a kosher Jewish religious scroll requires the placement of large numbers of closely spaced Hebrew

⁵ In fact, whether this is possible is still controversial, even after Applicant's invention. Yet, the rabbinical and Jewish legal status under all of the detailed religious legal provisions is not what is at issue in this application. What is at issue is whether Applicant's method was obvious to one of ordinary skill in this field at the time it was made. Within this field, it must certainly be found that it was not so.

letters by hand onto animal parchment. This must be done without a single letter ever coming into contact with any other letter on the scroll.

As a result, one of ordinary skill in this art would be expected to avoid using silk screening to make these scrolls. Printing using silk screening involves the application of ink to a substrate through a porous mesh. This commonly results in an image which spreads slightly as the ink travels through the holes of the silk screen and is absorbed into the substrate.

It is therefore to be expected that Hebrew letters placed onto parchment using silk screening would slightly expand or spread. But if a letter spreads slightly this can occasionally result in a portion of it contacting a neighboring letter above it, below it, or to the left or right. For the claimed religious scrolls, this is a particular problem in view of the structure of the text which has the Hebrew letters regularly extending above and below the line toward each other. See e.g., Applicant's Application at Figure 2, line 3, the seventh letter from the right. This is also a problem in view of the manner in which the letters of these scrolls are tightly packed together. *Id.*

In view of the manner in which the scroll letters are tight packed and are structured, the manner in which ink normally spreads through the silk screen pores and onto the substrate during silk screening, and the religious principle requiring the absence of even a single accidental contact, one of ordinary skill would not be favorably disposed to look toward the silk screen process to create these scrolls.

In the case of the longest scroll for example (a Torah scroll), it is necessary that over 300,000 letters be placed onto parchment by hand for each and every complete scroll produced, without a single letter ever bleeding, spreading, smearing or extending into another. If any part of even one letter of the hundreds of thousands contacts another one for any reason, the entire scroll becomes

completely invalid and unusable. In fact, spreading of ink did in fact pose a problem during development of the invention, a problem which had to be overcome using specialized inks, and which contradicts the speculated allegation of reasonable expectation of success.

It is also relevant that to comport with Jewish law a Jewish religious scroll must be prepared on kosher animal parchment, as recited in the claim. One can not simply assume success on the composition of this unusual material. There is no evidence at all of record that the method of Erickson would be successful on that particular composition. Nor does any other reference provide the least bit of guidance or reason to expect that silk screening would be successful to apply letters onto the particular material required by the claim.

One cannot just treat the claim as if this requirements is absent – every claim limitation has significance. The Office Actions have not cited any art of any sort indicating whether silk screening could be successfully conducted on kosher animal parchment, ignoring this very specific element of the claimed invention, particularly in view of the spreading issues that had to be avoided and the religious principles that had to be met.

These were all among the issues Rabbi Tesler had to deal with and solve. Research and experimentation was necessary to determine whether the method of the invention could be successfully developed. One could not simply “expect success” under the rather unusual conditions that had to be addressed.

Furthermore, the art cited by the Examiner could itself lead one away from the method of the invention. Erickson in a detailed discussion of prior art acknowledges some of the various difficulties associated with using silk screens. In one method, for example, one must be “careful to

difficulties associated with using silk screens. In one method, for example, one must be "careful to imbed the silk threads to a uniform depth in all areas so that a contact surface of uniform thickness is obtained with no thick edges which might cause paint or ink to run on the finished product". See, Erickson, Col. 1 lines 39-42. As discussed above, that ink could run on the product is contrary to the essential requirements of a religious scroll. Likewise, he states that "the mere act of imbedding ... will cause distortion of the emulsion so that the image or art work is not necessarily the same shape as it was originally made." See, Erickson, Col. 1 lines 61-68. This is also contrary to the religious requirements that the Hebrew letters must be of very particular and unambiguous shapes. Erickson further indicates that "[i]t is also apparent that the problem of placing and adhering of parts of the image or art work to the screen; such as a small period, a dot, a thin line, a small letter or shape standing by itself presents very serious difficulties." See, Erickson, Col. 1 lines 61-68. Having reviewed Erickson's comments, one would not be favorably inclined toward using a silk screen for a scroll explicitly requiring the placement of thousands of closely spaced small letters. As the current art still uses porous screens, even Erickson's own attempt to improve upon the art would not necessarily allay the concerns of one of ordinary skill regarding these numerous issues.

With respect to the third requirement for a *prima facie* case, it is necessary that the prior art reference (or references when combined) must teach or suggest all the claim limitations. Yet, other than by using Applicant's disclosure and perspective therein, no reference or combination thereof has been uncovered or cited by the Examiner with any teaching or suggestion at all regarding silk screening onto kosher parchment, as required by the claim.

The Examiner has heavily relied upon applicant's disclosure to overcome these various defects in the art of record and in the three elements of a *prima facie* case. But that reliance is improper. The Federal Circuit has stated that the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). It is respectfully submitted that the Examiner has not met his burden to so demonstrate.

It is also noteworthy that as previously discussed, it has been highly uncommon for most religious Jews subject to the requirement to prepare their own scroll to actually be able to do so. In the past, the specialized knowledge and experience of a trained scribe have been needed to prepare these scrolls, something which most observant Jews do not possess.

The fact that those subject to this law have been unable to directly fulfill it⁶ despite a binding religious requirement to do so, demonstrates that there has been a long felt need for an invention of the sort developed by Applicant, which affords most individuals the ability to write portions of these scrolls (or an entire scroll), without being a scribe, fulfilling the religious precept in a manner which to Applicant's knowledge has never been done before. That this long felt need has only now been met for the first time is further strong evidence of the non-obviousness of these claims. *Glaverhel*, 45 F.3d at 1555, *Stratoflex*, 713 F.2d at 1538-39.

⁶ This has resulted in other means by the individual of attempting to fulfill this law, which do not involve actually writing a scroll by oneself.

In summary, the pending claims are directed to a new method for printing religiously sacred scrolls which have very specific and exacting requirements. These Jewish religious scrolls are *sui generis* - they are objects in a class of their own. No one is believed to have previously attempted or succeeded at the method of the claims. That Applicant is the first to have accomplished this in several thousand years of this art is compelling evidence that his invention is non-obvious.

F. Claims 7-10 and 23-25 are also Patentable

Claims 7-10 and 23-25 are directed to the claimed methods of the independent claims, with the further use of ultraviolet and heat sensitive inks on a Jewish religious scroll.

Claims 7-8 and 23-25 were rejected based on Erickson in view of Churchwell. However, Churchwell is not prior art to the invention as discussed in Section VIII.A.1 above, so that rejection should be withdrawn. Claims 8-10 were rejected based on Erickson in view of Dunson, but no adequate showing has been made that Erickson qualifies as prior art, so that rejection should also be withdrawn.

Furthermore, as noted the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).” No such showing has been made. In fact, these inks are a non-obvious departure from the inks traditionally and consistently used in the preparation of Jewish religious scrolls. There is simply no evidence of anyone ever having previously used these types of inks in this context. This preferred embodiment is claimed since, over the course of research and development, Applicant needed to turn to the use of such special inks to overcome the spreading problem discussed above.

G. The Claims of Groups 4, 5 and 6 are also Patentable

Group 4 (claims 22, 27, 28, 33) relate to a method on kosher parchment with attached crowns. Group 5 (claims 12, 29, 30, 33) relate to a method for creating a Jewish religious scroll using *sirtut* (ritual guide lines), including preparation such that the tops of letters hang from those *sirtut* (claims 29, 30 and 33). Group 6 (claims 26, 31, 32, 33) relate to a method for creating a Jewish religious scroll in a ritual manner.

With respect to these claims, the Examiner has also not met his burden, as the art does not teach or suggest Applicant's method as recited in the independent claims, and further using those limitations. The Examiner's rejections essentially rely upon applicant's disclosure, which as discussed above is impermissible.

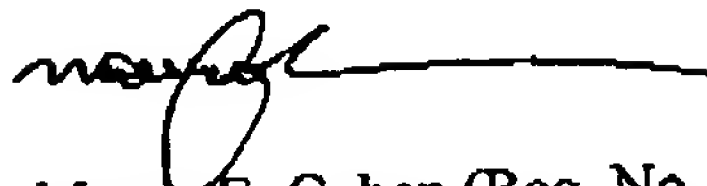
In fact, the non-prior art Dei'ah ve Dibur article initially cited by the Examiner is evidence of the difficulty of providing a method using attached crowns (Group 4). The second page indicates that experts can discern the difference between the writing of a scribe and a silk screen because in the latter some of the *tagim* (crowns) are detached from the letters. Applicant's method claimed in Group 4 overcomes that problem. Thus, if anything, Dei'ah ve Dibur, is evidence supporting patentability.

IX. Conclusion

In view of the above, a reversal of the rejections of the pending claims is respectfully requested.

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Respectfully submitted,



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X. Appendix

1. A method for preparing a Jewish religious scroll, comprising the steps of:
placing text of a Jewish religious scroll onto parchment with a human hand, wherein said parchment is kosher parchment, wherein said placement of said text is automated such that multiple letters are placed on said kosher parchment with a single movement of the human hand, and wherein said letters are placed onto said parchment such that no two letters in said scroll come into contact with each other.
2. A method as claimed in claim 1, wherein said scroll is a Torah scroll.
3. A method as claimed in claim 1, wherein said scroll is a Megillah scroll.
4. A method as claimed in claim 1, wherein said scroll is a Mezzuzah scroll.
5. A method as claimed in claim 1, wherein said scroll is a Tefillin scroll.
6. A method as claimed in claim 1, further comprising the steps of creating a silk screen template, said silk screen template having openings therein corresponding to the text of a Jewish religious scroll.
7. A method as claimed in claim 6, further comprising the step of providing ultraviolet ink onto said parchment through said openings.
8. A method as claimed in claim 6, further comprising the step of providing heat sensitive ink onto said parchment through said openings.
9. A method as claimed in claim 8, further comprising the step of illuminating said parchment to cause said ink to harden on said parchment.
10. A method as claimed in claim 7, further comprising the step of illuminating said parchment

- to cause said ink to harden on said parchment.
11. A method as claimed in claim 6, wherein said template comprises a reproduction of a pre-existing Jewish religious scroll.
 12. A method as claimed in claim 1, further comprising the step of etching said parchment with *Sirtut* grid lines.
 21. A method for preparing a Jewish religious scroll, comprising the steps of:
 - (a) placing sirtut onto a parchment, wherein said parchment is kosher parchment; and,
 - (b) placing the text of a Jewish religious scroll onto said parchment using a silk screening process;
 - (c) wherein said letters of said text are placed onto said kosher parchment with a human hand; and,
 - (d) wherein said letters are placed onto said scroll so that no two letters of said scroll come into contact with each other.
 22. A method as claimed in claim 21, wherein said letters have crowns, and wherein all of said letters placed onto said scroll have said crowns attached.
 23. A method as claimed in claim 21, wherein said letters comprise ultraviolet ink.
 24. A method as claimed in claim 21, wherein said letters comprise heat sensitive ink.
 25. A method as claimed in claim 21, wherein said letters have crowns, wherein all of said letters placed onto said scroll have said crowns attached, and wherein each of said letters comprise ink selected from the group consisting of: ultraviolet ink and heat sensitive ink.

26. A method as claimed in claim 21, further comprising the steps of reciting a blessing and imprinting the name of G-d on said scroll.
27. A method as claimed in claim 1, wherein said letters have crowns, and wherein all of said letters placed onto said scroll have said crowns attached.
28. A method as claimed in claim 26, wherein said letters have crowns, and wherein all of said letters placed onto said scroll have said crowns attached.
29. A method as claimed in claim 12, wherein the top of each letter in said scroll hangs from said sirtut.
30. A method as claimed in claim 21, wherein the top of each letter in said scroll hangs from said sirtut.
31. A method as claimed in claim 1, further comprising the steps of reciting a blessing and imprinting the name of G-d on said scroll.
32. A method as claimed in claim 29, further comprising the steps of reciting a blessing and imprinting the name of G-d on said scroll.
33. A method as claimed in claim 21, wherein: (a) said letters have crowns, all of said letters placed onto said scroll having said crowns attached; (b) wherein said method comprises the steps of reciting a blessing and imprinting the name of G-d on said scroll; and (c) wherein the top of each letter in said scroll hangs from said sirtut.